

Remarks

Claims 42-48, 52-56, 59, 62-66, 69 and 72-74 are pending in the instant application on entry of the present amendment. Claims 75-77, 80, 83, 86-89 and 92-94 have been canceled without prejudice or disclaimer. Claim 42 has been amended to recite "wherein said amino acid sequence is encoded by the cDNA plasmid contained in ATCC Deposit No. 75927" and claim 55 has been amended to recite "consisting of at least." Support for the amended claims is found throughout the specification as originally filed and in the claims pending in the instant application prior to entry of the present amendment. Accordingly, no new matter has been added to the claims.

In the specification, the paragraph spanning lines 20-27 on page 10 has been rewritten so as to correctly identify the GenBank Accession No. of rat Fas Ligand (SEQ ID NO:6) as U03470. Support for this correction of a typographical error lies in the knowledge that one of skill in the art would be able to search the publicly available GenBank database using the name of the molecule (rat Fas Ligand) or the sequence of the molecule as provided (SEQ ID NO:6) and determine that the correct Accession No. is U03470. Therefore, no new matter has been added to the specification.

Applicants respectfully request that the amendments and remarks of the present response be entered and made of record in the present application.

I Rejections Under 35 U.S.C. § 112, first paragraph

Written Description

The Examiner has maintained rejection of claims 55, 56, 59, 62-64, 75, 76, 86-89 and 92-94, under 35 U.S.C. § 112, first paragraph, as allegedly containing "subject matter which was not described in the specification in such a way as to reasonably convey

to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.” *See*, Paper No. 28, page 2.

Applicants respectfully assert that each claim pending before and after entry of the instant amendment meets the statutory requirements of 35 U.S.C. § 112, first paragraph. However, Applicants respectfully note that presently rejected claims 75, 76, 86-89 and 92-94 have been canceled without prejudice or disclaimer, thereby obviating their rejection. Applicants reserve the right to pursue the subject matter of the cancelled claims in one or more divisional applications.

The Examiner states that “[t]he rejection of claims 55, 56, 59, 62-64 is maintained because there is confusion over the metes and bounds of these claims … it is unclear if “of at least” is intended to mean “consisting of” or “comprising” … [t]he metes and bounds are not clearly set forth. See claim 65 for a suggested claim construction.” *See*, Paper No. 28, page 7 and pages 9-10. Applicants respectfully point out that rejected claim 55, as well as claims 56, 59 and 62-64 dependent therefrom, have been amended so as to recite “consisting of at least,” and to contain similar claim construction as claim 65 according to the Examiner’s suggestion. Accordingly, claims 55, 56, 59 and 62-64 do receive adequate written description support and their rejection under 35 U.S.C. § 112, first paragraph, should be reconsidered and withdrawn.

Accordingly, Applicants respectfully request that the present rejection of claims 55, 56, 59, 62-64, 75, 76, 86-89 and 92-94 under 35 U.S.C. § 112, first paragraph, for lack of adequate written description, be reconsidered and withdrawn.

Enablement

The Examiner has rejected claims 89 and 92-94, under 35 U.S.C. § 112, first paragraph, as allegedly containing “subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.” *See*, Paper No. 28, page 7.

Applicants respectfully traverse the rejection and assert that each claim pending before and after entry of the instant amendment meets the statutory requirements of 35 U.S.C. § 112, first paragraph. However, Applicants respectfully note that presently rejected claims 89 and 92-94 have been canceled without prejudice or disclaimer, thereby obviating the instant rejection. Applicants reserve the right to pursue the subject matter of the cancelled claims in one or more divisional applications.

Accordingly, Applicants respectfully request that the present rejection of claims 89 and 92-94 under 35 U.S.C. § 112, first paragraph, for lack of enablement, be reconsidered and withdrawn.

II Rejections Under 35 U.S.C. § 112, second paragraph

A. The Examiner has rejected independent claim 42 as well as claims 48, 52, 53 and 54, which depend therefrom, under 35 U.S.C. § 112, second paragraph, as allegedly being “indefinite over the recitation of ‘a polypeptide having the amino acid sequence expressed by a recombinant cell’ because there are at least two forms (TNF- γ - α and TNF- γ - β) expressed by a cell. It is unclear which form is intended.” *See*, Paper No. 28, page 9.

Applicants respectfully traverse the rejection and assert that each claim pending before and after entry of the instant amendment meets the statutory requirements of 35

U.S.C. § 112, second paragraph. The Examiner's attention is respectfully directed to claim 42, as well as claims 48, 52, 53 and 54, which have been amended herein. In light of the telephone conference on May 27, 2003, Applicants believe that the present amendment addresses the Examiner's concerns by including the recitation of "wherein said amino acid sequence is encoded by the cDNA plasmid contained in ATCC Deposit No. 75927."

Applicants further respectfully point out that claim 42, as well as claims 48, 52, 53 and 54 clearly recite "the cDNA plasmid contained in ATCC Deposit No. 75927." The specification as originally filed clearly describes the contents of ATCC Deposit No. 75927 as containing cDNA clone HUVEO91 encoding TNF- γ - α of the present invention. *See*, specification at page 4, lines 19-24. As cDNA clone HUVEO91 encodes TNF- γ - α , and not TNF- γ - β , Applicants respectfully suggest that the scope of the subject claims is clear.

Accordingly, Applicants respectfully request that the present rejection of claims 42, 48, and 52-54 under 35 U.S.C. § 112, second paragraph, be reconsidered and withdrawn.

B. The Examiner has rejected claims 55, 56, 59 and 62-64, under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite because "it is unclear if 'of at least' is intended to mean 'consisting of' or 'comprising'." *See*, Paper No. 28, page 9.

Applicants respectfully assert that each claim pending before and after entry of the instant amendment meets the statutory requirements of 35 U.S.C. § 112, second paragraph. Applicants respectfully point out that rejected claim 55, as well as claims 56, 59 and 62-64 dependent therefrom, have been amended so as to recite "consisting of at least," and to contain similar claim construction as claim 65 according to the Examiner's suggestion.

Accordingly, the metes and bounds of claims 55, 56, 59 and 62-64 are clearly set forth and satisfy the requirements of 35 U.S.C. § 112, second paragraph.

Accordingly, Applicants respectfully request that the present rejection of claims 55, 56, 59 and 62-64 under 35 U.S.C. § 112, second paragraph, be reconsidered and withdrawn.

III Specification

The Examiner has maintained the objection to the amendment filed on September 26, 2001, under 35 U.S.C. § 132, as allegedly introducing new matter into the specification. (*See*, Paper No. 28, page 7). Specifically, the Examiner objects to the introduction of “U034070” into the paragraph bridging lines 20-27 at page 10. *Id.* Applicants respectfully disagree and traverse this objection.

Applicants respectfully point out that the paragraph bridging lines 20-27 at page 10 has been further amended in order to correct an obvious typographical error in the previously amended GenBank identifier of a sequence already contained in Figure 2, and in the sequence listing of the application as originally filed. In support of this assertion Applicants respectfully direct the Examiner’s attention to the enclosed copy of GenBank database entry U03470. Applicants contend that “U03470” is the current and correct GenBank identifier for the sequence previously identified in the specification as “U034070,” and that the present amendment simply serves to provide the public with the typographically correct source reference for publicly available information used in the preparation of the present application. Furthermore, armed with the specification of the application as originally filed, one of ordinary skill in the art would have been able to routinely use sequence information to search publicly available databases and determine

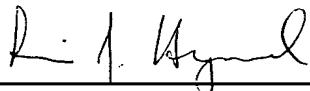
that "U03470" was the correct GenBank identifier for the sequence at issue. Accordingly, Applicants respectfully contend that "U03470" does not constitute new matter, and request that the Examiner's objection be reconsidered and withdrawn.

Conclusion

Applicants respectfully request that the amendment and remarks of the present response be entered and made of record in the present application. The present application is believed to be in condition for allowance. Early notice to that effect is earnestly solicited. If, in the opinion of the Examiner, a telephone conference would expedite prosecution, the undersigned can be reached at the telephone number indicated below. If a fee is required in connection with this paper, please charge Deposit Account No. 08-3425 for the appropriate amount.

Respectfully submitted,

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Enclosures
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